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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/024,478
Filing Date: December 21, 2001
Appellant(s): MELESKY, JAMES B.

Kirk Damman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/15/08 appealing from the Office action mailed 9/11/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|---------|------------------|---------|
| 4344505 | Waters et al | 08-1982 |
| 4832153 | Daw et al | 05-1989 |
| 5628158 | Porter | 05-1997 |
| 3896595 | Anghinetti et al | 07-1975 |

4312423

Helbig

01-1982

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 14, 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waters et al (4344505) in view of Helbig (4312423).

Waters et al shows an insulating assembly in combination with an existing attic access, the combination comprising an existing attic access (figure 2) having a surrounding structure (AF, its supporting structures, and C) integral to a ceiling of a building and providing access to the building's attic defining an existing attic access opening therethrough and having an existing trap door (figure 2, the covering which is attached to the pull down device) for closing the existing attic access opening, an insulating cover (26, 20,24,22, 28) placed on the surrounding structure and including the door a continuous frame (26, 20, 24, 22) having spaced side walls and spaced end walls and which frame is formed of a free standing insulating material having an upper surface and a lower surface, the frame defining an opening there through, the frame opening being aligned with said existing attic access opening (see figure 2), the frame being of a size and configuration so as to enclose the existing access opening when the lower surface is supported on the surrounding structure, a removable closure member (28) formed of a free

standing insulating material, the removable closure member including an upper portion forming flanges, the flanges extending laterally outward, the flanges sized and shaped to frictionally and snugly engage an upper surface of each of said side walls and end walls of the frame when the closure member is positioned on the frame in covering relationship with respect to the opening defined by the frame, the insulating material of the closure member and the frame being an expanded polymeric material (col 2 line 40), the trap door comprising a hatch, the trap door is attached to a fold down attic access ladder.

Waters et al does not show the closure member not being bonded to any portion of the continuous frame, the closure member including a central portion, the depending central portion being sized and shaped to fit within the frame opening defined by the frame and frictionally and snugly engage each of the side walls and the end walls of the frame inside the opening to create a first continuous seal with the frame when the closure member is positioned on the frame in a covering relationship with respect to the frame opening, the closure member being not hinged to and detaches from the frame when the first and second continuous seal are broken by a force applied to the closure member through the frame opening, leaving the frame enclosing the existing attic access opening, the first and second seals being generally orthogonal to each other when the member is positioned on the frame in covering relationship with respect to the opening defined by the frame.

Waters et al further discloses that any manner for allowing a person to move the cap away from its position over the opening is within the scope of the invention (col 3 lines 16-21), and an embodiment would be to hingedly move the cover away from the opening.

Helbig shows a removable closure member (24, 28), the closure member not being bonded to any portion of a frame (26), the closure member having a depending central portion (24, the flat portion and the sides thereof), the depending central portion being sized and shaped to fit within the frame opening and frictionally and snugly engage the frame (26) inside the opening to create a first seal with the frame, an upper portion forming flanges, the flanges (the part of 28 which extends beyond the sides of part 24) extending laterally outward relative to the depending central portion, the flanges being sized and shaped to frictionally and snugly engage an upper surface of the frame to create a second continuous seal with the frame when the member is positioned on the frame in covering relationship with respect to the opening defined by the frame, the closure member is not hinged to and detaches from the frame when the first and second seal being broken by a force applied to the member through the opening, the first and second seal being generally orthogonal to each other when the member is positioned on the frame in covering relationship with respect to the opening defined by the frame.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Waters et al to show the closure member including a central portion, the depending central portion being sized and shaped to fit within the opening defined by the frame and frictionally and snugly engage the frame inside the opening to create a first continuous seal with the frame when the closure member is positioned on the frame in covering relationship with respect to the opening defined by the frame, the flanges sitting on the top surface of the frame because having the flanges of the closure member fitting over an upper surface of a frame, a central portion of the closure member snugly fitting against the inside surfaces of the frame

would enable secure, easy precise positioning and supporting of the closure member on a frame as taught by Helbig.

Waters et al as modified by Helbig shows the closure member not being bonded to any portion of the continuous frame, the closure member including a central portion, the depending central portion being sized and shaped to fit within the frame opening defined by the frame and frictionally and snugly engage each of the side walls and the end walls of the frame inside the opening to create a first continuous seal with the frame when the closure member is positioned on the frame in a covering relationship with respect to the frame opening, the closure member being not hinged to and detaches from the frame when the first and second continuous seal are broken by a force applied to the closure member through the frame opening, leaving the frame enclosing the existing attic access opening, the first and second seals being generally orthogonal to each other when the member is positioned on the frame in covering relationship with respect to the opening defined by the frame.

3. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waters et al in view of Helbig as applied to claim 14 above, and further in view of Anghinetti et al (3896595).

Waters et al as modified shows all the claimed limitations except for the closure member having at least one handle mounted to extend from a lower surface of the depending central portion of the closure member so as to be accessible within the access opening when the insulating cover is in place.

Anghinetti et al discloses a handle (38) secured to the lower surface of the depending central body portion (18) of the closure member so as to be accessible within the access opening when the insulating cover is in place to facilitate easy maneuvering of the closure member.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Waters et al's modified structure to show the closure member having at least one handle mounted to extend from a lower surface of the depending central portion of the closure member so as to be accessible within the access opening when the insulating cover is in place because it would enable easy maneuvering of the closure member from the access opening as taught by Anghinetti et al.

4. Claims 24, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waters et al in view of Helbig as applied to claim 14 above, and further in view of Fuller (4281743) and Porter (5628158).

Waters et al as modified shows all the claimed limitations except for the closure member including at least first and second components each having opposing edges which are configured to cooperatively engage one another to create a tortuous seal path therebetween, and means for adhesively securing the opposing edges in inter-fitted relationship so as to form a unified closure member.

Fuller shows the closure member including at least first and second components (52, 53a, 53b, 52, figure 2) each having opposing edges which are configured to cooperatively engage one another to create a tortuous seal path therebetween, and means for securing the opposing edges in inter-fitted relationship to form a unified closure member.

Porter discloses adhesive means joining panel edges together.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Waters et al's modified structure to show the closure member including at

least first and second components each having opposing edges which are configured to cooperatively engage one another to create a tortuous seal path therebetween as taught by Fuller, and means for adhesively securing the opposing edges in inter-fitted relationship to form a unified closure member because having the closure member made of multiple components would opposing edges engaged one another to create tortuous seal path therebetween would enable the creation of a large closure member from smaller pieces and thus resulting in ease of manufacturing and transport, and having the edges of the components joined adhesively would ensure the proper securing of the components together at assembly as taught by Porter.

Waters et al as modified shows the closure member comprising at least two pieces, the two pieces having a seal between them when positioned within the frame in covering relationship with respect to the opening defined by the frame, and the pieces are adhered together.

5. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waters et al in view of Helbig as applied to claim 14 above, and further in view of Daw et al (4832153).

Waters et al as modified shows all the claimed limitations except for the closure member being coated with a fire retardant material.

Daw et al discloses a closure member being coated with a fire retardant material (col 2 lines 47) to ensure safety against fire.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Waters et al's modified structure to show the closure member being coated with a fire retardant material because it would protect the closure from fire as taught by Daw et al.

(10) Response to Argument

With respect to applicant's argument that Waters does not show a continuous frame and a removable closure member, examiner respectfully points out that the action sets forth above clearly points out the structures (26, 20, 24, 22) being the continuous frame and a removable closure member (28). Waters as modified by Helbig further shows the closure member being not hinged to and detaches from the frame when the first and second seals are broken by a force applied to the closure member through the frame opening.

With respect to applicant's statement to the cap 10, examiner clearly communicates with applicant that the reference Waters et al shows a removable closure member (28). The cap 10 as disclosed on column 3 lines 1-20 can be attached to the frame in other alternative manners. The reference thus discloses the cap being the closure member which can be mounted to the frame in other alternative means.

With respect to applicant's argument that Waters only discloses caps with inseparable covers, examiner respectfully points out that the reference discloses a cover (28) hingedly attached to the continuous frame (26, 20, 24, 20) and the reference further discloses that any manner for allowing a person to move the cap away from its position over the opening is within the scope of the invention (col 3 lines 16-21) and an embodiment would be to hingedly move the cover away from the opening. Thus, the reference does not explicitly disclose that the removable cover member must be attached to frame all the time. Waters as modified by Helbig shows the cover being removable as claimed. The argument is thus moot.

The reference further discloses the insulating cover being placed on the surrounding structure (AF, its supporting structures and C) on an existing attic opening. The insulating cover

has a continuous frame (26, 24, 20, 22) and closure member (28). The insulating cover is placed upon the surrounding structure. The claimed structures are clearly set forth in the action above. The argument is thus moot.

With respect to Helbig, the secondary reference is relied upon to show the teachings not shown in Waters et al. Helbig shows a central depending portion with sealing capacity for an enclosure member. Modifying Waters et al with Helbig results in Waters et al having a depending central portion with sealing capacity for the closure member as claimed, and the central portion has first and second seals as claimed. The combined references show the limitations as claimed.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, modifying Waters et al with Helbig would enable secure, easy precise positioning and supporting of the closure member on a frame as taught by Helbig and is thus encouraged.

Applicant's arguments to other secondary references are also moot in view of the statements above.

With respect to the Declaration from Tom Donofrio and George Temme, examiner respectfully sets forth the following. First of all, although they refer to the Energy Guardian kits, it is unclear what structures are involved in the kits. Are they referring to the structures claimed? Are they referring to the structures indicated as allowable in the application? What make up the kits as mentioned? A quick look at applicant's web site also does not clarify the issues. Secondly, how many sets of the kits have been used by them so as to qualify as evidencing commercial success? Thirdly, it is expected that once a person limits the area of escape by air between structures by providing more sealing surfaces, less air would escape a structure resulting in a more insulating structure. The combination of the references is thus obvious as set forth above. Fourthly, as a kit contains many parts, which part/parts do they use to satisfy their insulating need? Do they use only the parts as claimed? As also is evidenced, the declaration is insufficiently specific to overcome the rejection. Their declarations are thus not persuasive.

With respect to applicant's statement that Tom Donofrio specifically refers to applicant's claimed two-part design, examiner respectfully states that the declaration is insufficiently clear and does not commensurate with the scope of the claim 14. Furthermore, George Temme is an inventory coordinator for his company, is he directly involved in the purchasing of the product or negotiations of the purchase of the product? What factors were involved in his company's purchase of the product? Is it commercial relationship, advertisement, special discounts, technical solutions or something else? Does his company only use the parts in the claims to

arrive at the better results? Are there other reasons for better insulating results, like better installation or housing structural designs? The declaration by George Temme is thus also found not persuasive.

With respect to exhibit Q, applicant states that the statement “because the lid of the Energy Guardian kits fits right into the frame without any hooks or devices to secure the air” refers to the closure member’s frictional and snug engagement with the closure member and map claim 14, examiner respectfully disagrees. The exhibit certainly does not map the claim 14. What are the shapes of the lid and the frame? The exhibit does not state anything about “frictional and snug engagement with the closure member” as set forth by applicant. The exhibit does not refer to the central portion and other claimed limitations of claim 14. The exhibit does not commensurate with the scope of the claim. Argument is thus moot.

With respect to exhibit D, respectfully states that the exhibit does not commensurate with the scope of the claims. It is unclear what structures AEM Custom Builders refer to. Also, the exhibit is insufficient to demonstrate unexpected result and commercial success.

With respect to exhibit E and EE, examiner respectfully states that the exhibit does not commensurate with the scope of the claims. It is unclear what structures Aleshire refer to. What is the make up of the structures? How many units have been used/sold? How many clients use the product? The exhibit is thus insufficient to demonstrate unexpected result and commercial success also.

With respect to exhibit Q, applicant states “air sealing qualities of [Applicant’s] kits are great” and that these qualities are directly traceable to the claimed sealing relationship, examiner respectfully disagrees. There is insufficient information on the exhibit to clearly point out that

the exhibit, is describing the claim 14. The exhibit does not clearly sets forth any structures that can clearly relate to the claim 14.

With respect to Vic Aleshire of Exhibits E and EE, examiner respectfully points out once again that the exhibits have insufficient information to clearly point out that the exhibits are describing claim 14. The exhibits are thus not commensurate with the scope of the claim.

With respect to Doug Ryse's testimonial, Exhibit M, the exhibit does not commensurate with the scope of the claim. It is unclear from the exhibit what the structure of the Kit is, and how it relates to the claim.

With respect to applicant's statement of having shown commercial success in the form of replacement of earlier products and increased market share, examiner states that applicant has not provided sufficient evidence that the commercial success is due to technical feature of the product or due to other commercial factors.

With respect to exhibits Q, R, S, V, F, EE, FF, U, W, DD, examiner respectfully states that the exhibits do not have information commensurate with the scope of the claims. It is unclear from the exhibits what kind of structures are involved. It is also unclear if any commercial success would result from the structures as claimed.

1. The Declaration under 37 CFR 1.132 filed 7/16/07 is insufficient to overcome the rejection of claims 14, 22, 24-25, 27-29, 31-32 based upon Waters et al, Helbig, Daw et al, Porter, Fuller, Anghinetti, as set forth in the last Office action because the claims are obvious in view of the references. The Exhibits in the Declaration have been addressed above and will not be repeated here.

With respect to applicant's statement about examiner raising a host of additional questions page 35 of the appeal brief lines 1-5, examiner would like to point out that these questions are to set forth that the declarations were insufficient to overcome the rejection per secondary considerations.

With respect to Anghinetti, the reference shows a latch for opening and closing an access opening on an upper part of a building. Applicant's invention and Waters et al are related to an access opening on upper part of a building structure. The reference Anghinetti is thus analogous. Modifying Waters et al with Anghinetti thus shows all the claimed limitations including latch for opening and closing an access opening on an upper part of a building.

Allowable Subject Matter

Claims 17, 21 are allowed.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Phi D. A/

Phi Dieu Tran A

Conferees:

Brian Glessner /BG/

Meredith Petravick /mcp/